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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/663,687

09/19/2000

Shiro Takagi

016907/1145

5292

22428

7590

05/14/2004

FOLEY AND LARDNER
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WASHINGTON, DC 20007

EXAMINER

PHAM, THIERRY L

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/663,687

Applicant(s)

TAKAGI, SHIRO

Examiner

Thierry L Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-7 and 11-14 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 8-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Oath/Declaration

1. Responsive to defective/unsigned Declaration had been received and acknowledged and entered as paper no. 2.
2. Change of Address/Power of Attorney had been received and acknowledged and enter as paper no. 6

Claim Rejections - 35 USC § 112

3. Claims 11, 13-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 11, 13-14 recites the limitation "restored by supplementing portion" in page 19, lines 3-5 and lines 18-20 and page 20, lines 16-17. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. Claims 1-3, 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al (U.S. 6611352), and in view of Nishimo (U.S. 6116510).

Regarding claims 1 & 8, Suzuki teaches an image forming apparatus (image forming apparatus, fig. 1) comprising:

- (1) a controller (comparing and determining unit, fig. 4) for determining whether or not document data given have a capacity larger than a first predetermined value (determines

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and compares if the input image data is greater than the predetermined reference value, col. 10, lines 45-63);

(2) a reducing portion (thinning control unit, fig. 4) for reducing the document data by a second predetermined value, if the controller determines that the document data have a greater capacity than the first predetermined value (if the inputted document data is greater than the predetermined reference value, then the thinning control unit reduces the image data, col. 5, lines 42-52 and col. 10, lines 45-65).

However, Suzuki does not explicitly teach an image forming apparatus comprising: (a) a first code pattern creating portion for creating code pattern by encoding the document data; (b) a second code pattern creating portion for encoding the document data reduced by the reading portion to create code patterns; and (c) a print function for printing code patterns.

Nishino, in the same field of endeavor for image forming apparatus, teaches (a) a first code pattern creating portion (encoding operation controller, fig. 3) for creating code pattern (code pattern, fig. 1) by encoding the document data; (b) a second code pattern creating portion (encoding operation controller, fig. 3, col. 5, lines 30-42) for encoding the document data reduced by the reducing portion to create code patterns (code pattern, fig. 1); and (c) a print function (printer, fig. 3, col. 5, lines 59-62) for printing code patterns.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Suzuki as per teachings of Nishino because of a following reason: (1) to prevent code pattern image from being fraudulently copied and protect the copyright of the information contained in the image (Nishino, col. 1, lines 39-46); (2) by reducing the inputted image/document data; therefore, to allocate and free-up storage memory of the forming apparatus.

Therefore, it would have been obvious to combine Suzuki with Nishino to obtain the invention as specified in claim 1.

Regarding claims 2 & 9, Nishino further teaches an image forming apparatus according to claim 1, wherein the print function includes a function for forming images

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(col. 5, lines 59-62) on the front side of a recording medium based on the document data, and forming the code patterns created by at least one of the first code pattern creating portion and the second code pattern creating portion. In addition, Suzuki also teaches an image forming apparatus for forming images on both sides of a recording medium (col. 9, lines 53-67).

Regarding claims 3 & 10, Suzuki further teaches an image forming apparatus according to claim 1, wherein the controller includes control function (size measurement control unit, col. 10, lines 45-67) for determining whether or not the document data have a capacity larger than the first predetermined value (determines whether the detected document is larger than the reference size, col. 10, lines 45-67 and col. 11, lines 33-45) after an image developing portion has created print images based on the document data and a print engine (image forming apparatus, fig. 1) has printed the print image on the front side of the recording medium.

Allowable Subject Matter

6. Claims 4-7, 11-14 allowed.

The following is a statement of reasons for the indication of allowable subject matter: a controller for determining the temporary document data created by the creating portion as final document, if the controller determines that no data have been deleted from the code patterns; and a supplementing portion for restoring predetermined data from data other than the code pattern and incorporating the restored predetermined data into the temporary document data created by the creating portion to restore the final document data, if the controller determines that the predetermined data have been deleted from the code patterns.

7. Claims 4 and 11 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

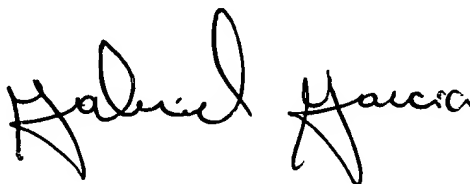
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L Pham whose telephone number is (703) 305-1897. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (703)308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham

TP

A handwritten signature in black ink, appearing to read "Gabriel Garcia". The signature is fluid and cursive, with the first name "Gabriel" and the last name "Garcia" clearly distinguishable.

GABRIEL GARCIA
PRIMARY EXAMINER